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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,847

12/10/2003

Peter A. Carr

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EXAMINER

LU, FRANK WEI MIN

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,847

Applicant(s)

CARR ET AL.

Examiner

Frank W. Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to a method for generating a nucleic acid, classified in class 435, subclass 91.2.
 - II. Claims 2-4 and 8, drawn to a method for generating a nucleic acid, classified in class 435, subclass 91.2.
 - III. Claim 5, drawn to a method for positioning mobile components on a surface based on the affinity of an attached molecule for nucleic acids which have been positioned on that surface, classified in class 435, subclass 6.
 - IV. Claim 6, drawn to a method for monitoring the generation of a nucleic acid, classified in class 435, subclass 91.2.
 - V. Claim 7, drawn to a method for controlling the movement of a nucleic acid molecule by stepwise repositioning of the molecule, classified in class 435, subclass 6.
 - VI. Claim 9, drawn to a method for removing or controlling errors in nucleic acid molecules, classified in class 435, subclass 6.
 - VII. Claims 11-13, drawn to a method for removing or controlling errors in nucleic acid molecules, classified in class 435, subclass 6.
2. The inventions are distinct, each from the other because of the following reasons:

Group I and Groups II to VII are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct

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searches will have to be performed. For example, the search required for Group I such as said second 3' region and said first 5' region comprise identical nucleic acid sequences of claim 1 is not required for Groups II to VII while the search required for Group II such as step b) of claim 2 or the search required for Group III such as positioning mobile components on a surface of claim 5 or the search required for Group IV such as monitoring the generation of a nucleic acid of claim 6 or the search required for Group V such as controlling the movement of a nucleic acid molecule by stepwise repositioning of the molecule of claim 7 or the search required for Group VI such as step b) of claim 9 or the search required for Group VII such as step b) of claim 10 is not required for Group I.

Group II and Groups III to VII are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group II such as step b) of claim 2 is not required for Groups III to VII while the search required for Group III such as positioning mobile components on a surface of claim 5 or the search required for Group IV such as monitoring the generation of a nucleic acid of claim 6 or the search required for Group V such as controlling the movement of a nucleic acid molecule by stepwise repositioning of the molecule of claim 7 or the search required for Group VI such as step b) of claim 9 or the search required for Group VII such as step b) of claim 10 is not required for Group II.

Group III and Groups IV to VII are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group III such as positioning mobile components on a surface of claim 5 is not required for Groups IV to VII

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while the search required for Group IV such as monitoring the generation of a nucleic acid of claim 6 or the search required for Group V such as controlling the movement of a nucleic acid molecule by stepwise repositioning of the molecule of claim 7 or the search required for Group VI such as step b) of claim 9 or the search required for Group VII such as step b) of claim 10 is not required for Group III.

Group IV and Groups V to VII are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group IV such as monitoring the generation of a nucleic acid of claim 6 is not required for Groups V to VII while the search required for Group V such as controlling the movement of a nucleic acid molecule by stepwise repositioning of the molecule of claim 7 or the search required for Group VI such as step b) of claim 9 or the search required for Group VII such as step b) of claim 10 is not required for Group IV.

Group V and Groups VI and VII are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group V such as controlling the movement of a nucleic acid molecule by stepwise repositioning of the molecule of claim 7 is not required for Groups VI and VII while the search required for Group VI such as step b) of claim 9 or the search required for Group VII such as step b) of claim 10 is not required for Group V.

Groups VI and VII are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will

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have to be performed. For example, the search required for Group VI such as step b) of claim 9 is not required for Group VII while or the search required for Group VII such as step b) of claim 10 is not required for Group VI.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

May 25, 2006

A handwritten signature in black ink, appearing to read 'Frank Lu', is positioned above the printed name.

FRANK LU
PRIMARY EXAMINER